

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the claims

As shown in the foregoing AMENDMENT TO THE CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

Claim 1 is amended to require that the second information is a printed image “*in the form of letters, numbers or geometrical figures*” which was originally recited in claim 12. Claim 1 also recites that the second information is “*printed [...] by a digital printing method*” which was originally recited in claim 13. Moreover, claim 1 recites that “*the form of the letters, numbers or geometrical figures forming the second information is different from the form of the characters or patterns forming the first information.*” This feature is found Figs. 3 and 4 in reference to elements 30/36 and 44/46, respectively.

Claims 12 and 13 are thus cancelled without prejudice or disclaimer.

Claim 24 is amended in view of the amendments made in claim 1.

It is submitted that there is clear support for the amendatory language from the originally-filed application. Further, it is submitted that the amendment complies with U.S. rules and laws regarding claim language.

Entry of the amendment to the claims is respectfully requested in the next Office communication.

2. Rejection of claims 1, 2-5, 9, 11, 12, 14, 15, and 17-22 under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 5,688,587 (*Burchard*)

Reconsideration of this rejection is respectfully requested, in view of the amendments to claim 1, on the basis that *Burchard* fails to disclose each and every recited element of amended claim 1. The remaining claims depend from claim 1, and are therefore patentable as containing all of the recited elements of claim 1, as well as for their respective recited features.

As discussed above, claim 1 is amended to recite that the second information is a printed image “*in the form of letters, numbers or geometrical figures*” and is “*printed [...] by a digital printing method,*” and that “*the form of the letters, numbers or geometrical figures forming the second information is different from the form of the characters or patterns forming the first information.*”

It is submitted that *Burchard* fails to disclose or suggest the combination of these features of amended claim 1.

The rejection particularly relies on Figs. 2 and 7 (or any of the other drawing figures) of *Burchard* which clearly do not show that the form (i.e., physical shape) of the first information is different from the form of the second information. Nowhere in the disclosure of *Burchard* is there a description of a security element having every feature required by claim 1.

The examiner’s response to the applicant’s former arguments indicates that the claims (before the instant amendment) only required that the information in the gaps is different, and not necessarily the physical shape or form of the elements within the gaps is different. The current amendment to the claims obviously makes clear that the form of the first information and second information are different from one another which, as submitted above, is neither taught nor suggested in *Burchard*.

In view of these observations, it is clear that the claims of this rejection are not anticipated by *Burchard*. Accordingly, withdrawal of this rejection is kindly requested.

3. Rejection of claims 1, 2-5, 9, 11, 12, 14, 15, and 17-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*)

Reconsideration of this rejection is respectfully requested in view of the amendment to claim 1, and the observations with regard to the rejection of claim in section (2) of these remarks.

The basis for modifying the anticipation rejection of claim 1 into the instant rejection based on obviousness is the assertion that the skilled person would recognize from *Burchard* that the first and second information in the security element thereof can

differ in color. As pointed out above, claim 1 has been amended to clearly indicate that the differences between the first and second information is based on the form of the letters, numbers or geometrical figures forming the second information which are different in form from the characters or patterns forming the first information.

There is no indication in *Burchard* that the skilled person could understand to provide second information in gaps defining first information which is different in form one another. Indeed, as previously argued in the reply filed December 5, 2008 incorporated herein by reference, the skilled person would understand from *Burchard* to provide first and second information having the same form (while differing in color).

In view of these observations, it is submitted that the security element recited in claim 1 and modified by the claims dependent therefrom is not obvious over the teachings of *Burchard*. Accordingly, claim 1 and the claims dependent therefrom are patentable. Withdrawal of this rejection is respectfully requested.

4. Rejection of claims 1, 16, and 23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent application publication 2005/0151368 (*Heim*) in view of U.S. patent 5,688,587 (*Burchard*)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to amended claim 1, from which claims 16 and 23 depend.

The requirements of amended claim 1 are discussed above in detail and require that the second information within the gaps is different in form from the first information defining the respective gap within which the second information is disposed.

The *Heim* publication discloses a security element 2, 4 applied to a security document and including gaps 9 (Figs. 1 and 8; abstract; paragraphs [0047], [0064], and [0065]).

As acknowledged in the Office action on page 8, the *Heim* publication fails to disclose a printed image forming visually and/or machine readable second information disposed in the gaps, in register, and further wherein the content of the first information

and second information is different. Additionally, since the *Heim* publication fails to disclose the content of the first information and second information is different, it follows that the *Heim* publication also fails to disclose the second information within the gaps is different from the first information of the respective gap within which the second information is disposed, as is required by amended claim 1.

The Office action turns to *Burchard* to cure the deficiencies of the *Heim* publication. However, the shortcomings of *Burchard* are discussed above in detail, and *Burchard* fails to cure the deficiencies of the *Heim* publication. Therefore, the skilled person would not derive the security element of claim 1 from the combination of *Burchard* and *Heim*.

Accordingly, a *prima facie* case of obviousness cannot be maintained with respect to amended claim 1, from which claims 16 and 23 depend, and withdrawal of this rejection is respectfully requested.

5. Rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 5,573,639 (*Schmitz*)
Rejection of claims 6, 7, and 27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent application publication 2005/0151368 (*Heim*)
Rejection of claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 6,344,261 (*Kaule*)
Rejection of claims 24 and 26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 6,352,804 (*Sakamoto*)
Rejection of claims 25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 6,352,804 (*Sakamoto*) and further in view of U.S. patent application publication 2005/0151368 (*Heim*)

Reconsideration of these rejections is requested in view of the amendment to claim 1 and the discussion provided above. The claims of the above-identified rejections

are dependent from claim 1. It is respectfully submitted that none of *Schmitz, Heim, Kaule* and *Sakamoto*, make up for the aforementioned shortcomings of *Burchard* as discussed above with respect to amended claim 1, from which all remaining pending claims depend.

In particular, none of the above cited patents and publications discloses second information within the gaps that is different in form from the first information of the respective gap within which the second information is disposed, as is required by amended claim 1.

Accordingly, it is submitted that the proposed combinations of *Schmitz, Heim, Kaule* and *Sakamoto* with *Burchard*, and *Burchard* alone fail to establish a *prima facie* case of obviousness with respect to amended claim 1, from which all remaining pending claims depend. Therefore, withdrawal of these rejections is respectfully requested.

6. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

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